REMARKS

In response to the final Office Action of September 5, 2007, Applicants have amended the claims, which when considered with the following remarks, is deemed to place the present application in condition for allowance. Favorable consideration and allowance of all pending claims is respectfully requested. The amendments to the claims have been made in the interest of expediting prosecution of this case. Applicants reserve the right to prosecute the same or similar subject matter in this or another application.

Claims 1-32 are pending in this application. By this Amendment, Claims 1, 18 and 20 have been amended, Claim 17 has been cancelled without prejudice and new Claims 33-35 have been added. Support for amended Claims 1, 18 and 20 and new Claims 33-35 can be found throughout the specification, e.g., page 1, lines 1-19, page 7, line 8 through page 19, line 19 and page 30, line 5 through page 41, line 22. Applicants respectfully submit that no new matter has been added to this application.

In the last Office Action mailed September 5, 2007, the Examiner provisionally rejected Claims 10 and 22-23 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over copending U.S. Application No. 10/699,510. Upon resolution of all outstanding issues remaining in the Office Action, Applicants will consider the timely submission of a Terminal Disclaimer.

In the last Office Action mailed September 5, 2007, the Examiner provisionally rejected Claims 20 and 22-30 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over copending U.S. Application No. 10/699,507. Upon resolution of all

outstanding issues remaining in the Office Action, Applicants will consider the timely submission of a Terminal Disclaimer.

In the last Office Action mailed September 5, 2007, the Examiner provisionally rejected Claims 20, 22-24 and 26-30 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over copending U.S. Application No. 10/699,508. Upon resolution of all outstanding issues remaining in the Office Action, Applicants will consider the timely submission of a Terminal Disclaimer.

In the last Office Action mailed September 5, 2007, the Examiner provisionally rejected Claims 1 and 17-18 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over copending U.S. Application No. 10/779,422. Upon resolution of all outstanding issues remaining in the Office Action, Applicants will consider the timely submission of a Terminal Disclaimer.

In the last Office Action mailed September 5, 2007, the Examiner rejected Claims 1-2, 8-10 and 16-26 under 35 U.S.C. §102(e) as being anticipated by Kolosov et al. U.S. Publication No. 2004/0123650 ("Kolosov et al."). This rejection is respectfully traversed.

According to the Examiner in the Office Action mailed September 5, 2007, "it is reiterated in the description by Kolosov 'of *most* any flowable material that may be a commercial product itself or an ingredient within a commercial product' being a candidate for screening in the combinatorial library, there is no specific exclusion of lubricating oil compositions having a major amount of a base oil and a minor amount of an additive therein." Thus, it is the Examiner's apparent belief that Kolosov et al. anticipate Claims 1-2, 8-10 and 16-26 since the "entire disclosure of the Kolosov et al. reference is considered prior art, including all

embodiments under the broad teaching of lubricating oil commercial products." This wholly

unsupported premise cannot possibly serve as a basis for this rejection.

It is well established that in order for a claim to be anticipated, a single prior art reference

must disclose each and every element of the claimed invention, *either expressly or inherently*.

Lewmar Marine, Inc. v. Barient, Inc., 827 F.2d 744, 747, 3 USPQ2d 1766, (Fed. Cir. 1987); *cert.*

denied, 484 U.S. 1007 (1988). There is no express disclosure in Kolosov et al. of a

combinatorial lubricating oil composition library comprising "lubricating oil composition

property data for a vast number of a plurality of different lubricating oil compositions comprising

(a) a major amount of at least one base oil of lubricating viscosity and (b) a minor amount of at

least one lubricating oil additive ... wherein the plurality of different lubricating oil compositions

have a phosphorous content at or below 0.08 wt. % and a sulfur content below 0.2 wt. %" as

presently recited in amended Claim 1. There is also no express disclosure in Kolosov et al. of a

high throughput method for producing a combinatorial lubricating oil composition library, under

program control, comprising "(a) providing a library of a vast number of a plurality of different

lubricating oil composition samples comprising (i) a major amount of at least one base oil of

lubricating viscosity and (ii) a minor amount of at least one lubricating oil additive ... wherein

the plurality of different lubricating oil compositions have a phosphorous content at or below

0.08 wt. % and a sulfur content below 0.2 wt. %; (b) measuring lubricating oil composition

properties of each sample to provide lubricating oil composition property data for each sample;

and, (c) outputting the results of step (b)" as presently recited in amended Claim 20.

In fact, the Examiner does not identify anywhere in the Office Action of any express

disclosure in Kolosov et al. Instead, the Examiner only notes on pages 11 and 12 that (1) that

Kolosov et al. discloses that the invention may be used to screen or test flowable materials such as lubricants; (2) the invention disclosed in Kolosov et al has particular utility in connection with the screening of a number of different material forms including oils; and (3) the Kolosov et al. invention can be used to analyze the resulting properties of a particular flowable material or the relative or comparative effects that an additive has upon a particular flowable material. Certainly, this is no express disclosure in Kolosov et al. a combinatorial lubricating oil composition library comprising "lubricating oil composition property data for a vast number of a plurality of different lubricating oil compositions comprising (a) a major amount of at least one base oil of lubricating viscosity and (b) a minor amount of at least one lubricating oil additive ... wherein the plurality of different lubricating oil compositions have a phosphorous content at or below 0.08 wt. % and a sulfur content below 0.2 wt. %." Nor is it an express disclosure of a high throughput method for producing a combinatorial lubricating oil composition library, under program control, comprising "(a) providing a library of a vast number of a plurality of different lubricating oil composition samples comprising (i) a major amount of at least one base oil of lubricating viscosity and (ii) a minor amount of at least one lubricating oil additive ... wherein the plurality of different lubricating oil compositions have a phosphorous content at or below 0.08 wt. % and a sulfur content below 0.2 wt. %; (b) measuring lubricating oil composition properties of each sample to provide lubricating oil composition property data for each sample; and, (c) outputting the results of step (b)."

With respect to an inherent disclosure, it is well established that inherency cannot be established by *probabilities or possibilities*. As summarized in *Continental Can Company USA v. Monsanto Company*, 948 F.2d 1264, 1269, 20 USPQ2d 1746, 1749 (Fed. Cir. 1991),

"Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient." As is the case here, the disclosure in Kolosov et al. that the method and system therein can analyze most any flowable material which may be a lubricant that may contain an additive does not rise to the level of an inherent disclosure. For there to be an inherent disclosure, the outcome must occur *each and every time*.

As acknowledged by the Examiner in the Office Action, a lubricant can be a concentrate containing a major amount of a lubricating oil additive and a minor amount of a base oil of lubricating viscosity. Moreover, a lubricant can be a grease, jelly, e.g., K-Y jelly, as well as powders, e.g., dry graphite, PTFE, etc., formulated with water and can be used as is such that all lubricants may not even require an additive or, for that matter, be used in a lubricating oil composition. Thus, Kolosov et al. cannot possibly disclose "a plurality of different lubricating oil compositions comprising (a) a major amount of at least one base oil of lubricating viscosity and (b) a minor amount of at least one lubricating oil additive... wherein the plurality of different lubricating oil compositions have a phosphorous content at or below 0.08 wt. % and a sulfur content below 0.2 wt. %" each and every time.

Accordingly, Kolosov et al. do not inherently disclose a combinatorial lubricating oil composition library comprising "lubricating oil composition property data for a vast number of a plurality of different lubricating oil compositions comprising (a) a major amount of at least one base oil of lubricating viscosity and (b) a minor amount of at least one lubricating oil additive... wherein the plurality of different lubricating oil compositions have a phosphorous content at or below 0.08 wt. % and a sulfur content below 0.2 wt. %" as presently recited in amended Claim 1.

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Nor do Kolosov et al. inherently disclose a high throughput method for producing a combinatorial lubricating oil composition library, under program control, comprising "(a) providing a library of a vast number of a plurality of different lubricating oil composition samples comprising (i) a major amount of at least one base oil of lubricating viscosity and (ii) a minor amount of at least one lubricating oil additive ... wherein the plurality of different lubricating oil compositions have a phosphorous content at or below 0.08 wt. % and a sulfur content below 0.2 wt. %; (b) measuring lubricating oil composition properties of each sample to provide lubricating oil composition property data for each sample; and, (c) outputting the results of step (b)" as presently recited in amended Claim 20.

As Kolosov et al. do not expressly or inherently disclose each and every element of the claimed invention, amended Claims 1-2, 8-10 and 16-26 are novel over Kolosov et al. Therefore, withdrawal of the rejection of amended Claims 1-2, 8-10 and 16-26 under 35 U.S.C. §102(e) is respectfully requested.

With respect to new Claim 33, nowhere does Kolosov et al. disclose a combinatorial lubricating oil composition library comprising "lubricating oil composition property data for each of a plurality of different lubricating oil compositions comprising (a) a major amount of at least one base oil of lubricating viscosity and (b) a minor amount of at least one lubricating oil additive, wherein the plurality of different lubricating oil compositions is at least 20, and further wherein the lubricating oil composition property data is derived from conditions associated with an engine test" as presently recited in new Claim 33. In contrast, Kolosov et al. simply disclose a system and method for screening a library of a multitude of genera of flowable material for rheological properties. Kolosov et al. further disclose that one of the genera of material which

can be tested includes lubricants, which may or may not contain an additive. However, Kolosov

et al. provides no disclosure of lubricating oil composition property data derived from conditions

associated with an engine test much less data for each of a plurality of different lubricating oil

compositions comprising (a) a major amount of at least one base oil of lubricating viscosity and

(b) a minor amount of at least one lubricating oil additive. Accordingly, new Claim 33 also

recites novel subject matter over Kolosov et al. Similarly, new Claims 34 and 35, which depend

from new Claim 33, are also believed to recite novel subject matter over Kolosov et al. for at

least the same reasons as new Claim 33.

In the last Office Action mailed September 5, 2007, the Examiner rejected Claims 3-7

and 11-15 under 35 U.S.C. §103(a) as being obvious over Kolosov et al.

The deficiencies of Kolosov et al. discussed above with respect to the rejection of Claim

1, from which Claims 3-7 and 11-15 depend, apply with equal force to this rejection. Kolosov et

al. provide no teaching, suggestion or motivation of a combinatorial lubricating oil composition

library comprising "lubricating oil composition property data for a vast number of a plurality of

different lubricating oil compositions comprising (a) a major amount of at least one base oil of

lubricating viscosity and (b) a minor amount of at least one lubricating oil additive... wherein the

plurality of different lubricating oil compositions have a phosphorous content at or below 0.08

wt. % and a sulfur content below 0.2 wt. %" as presently recited in amended Claim 1.

In contrast, Kolosov et al. simply disclose a system and method for screening a library of

a multitude of genera of flowable material for rheological properties. Kolosov et al. further

disclose that one of the genera of material which can be tested includes lubricants, which may or

may not contain an additive. However, Kolosov et al. have no appreciation that a combinatorial

lubricating oil composition library can be produced by screening a plurality of different

lubricating oil composition samples having a phosphorous content at or below 0.08 wt. % and a

sulfur content below 0.2 wt. % comprising (i) a major amount of at least one base oil of

lubricating viscosity and (ii) a minor amount of at least one lubricating oil additive. In contrast,

Kolosov et al. contemplate lubricants having no express limitation with respect to the

phosphorous and sulfur content therein and therefore the Kolosov et al. teaching does not

exclude lubricants containing high amounts of phosphorous and sulfur. Thus, nothing in

Kolosov et al. would lead one skilled in the art to look to Kolosov et al. to modify the system and

method for screening a library of a multitude of genera of flowable material for rheological

properties disclosed therein and arrive at the presently recited combinatorial library comprising

"lubricating oil composition property data for a vast number of a plurality of different lubricating

oil compositions comprising (a) a major amount of at least one base oil of lubricating viscosity

and (b) a minor amount of at least one lubricating oil additive... wherein the plurality of different

lubricating oil compositions have a phosphorous content at or below 0.08 wt. % and a sulfur

content below 0.2 wt. %" as presently recited in amended Claim 1, from which Claims 3-7 and

11-15 ultimately depend. Accordingly, Claims 3-7 and 11-15 are believed to be nonobvious, and

therefore patentable, over Kolosov et al. Therefore, withdrawal of the rejection of Claims 3-7

and 11-15 under 35 U.S.C. §103(a) is respectfully requested.

With respect to new Claim 33, nowhere does Kolosov et al. provide any teaching,

suggestion or motivation of a combinatorial lubricating oil composition library comprising

"lubricating oil composition property data for each of a plurality of different lubricating oil

compositions comprising (a) a major amount of at least one base oil of lubricating viscosity and

(b) a minor amount of at least one lubricating oil additive, wherein the plurality of different lubricating oil compositions is at least 20, and further wherein the lubricating oil composition property data is derived from conditions associated with an engine test" as presently recited in new Claim 33.

Rather, Kolosov et al. simply disclose a system and method for screening a library of a multitude of genera of flowable material including lubricants, which may or may not contain an additive, for rheological properties such as viscosity, viscoelasticity (e.g., shear dependent viscoelasticity), shear thinning, shear thickening, yield, stress and the like. It is not seen where there is any appreciation in Kolosov et al. that the library will comprise lubricating oil composition property data derived from conditions associated with an engine test for each of a plurality of different lubricating oil compositions comprising (a) a major amount of at least one base oil of lubricating viscosity and (b) a minor amount of at least one lubricating oil additive. In contrast, Kolosov et al. are merely concerned with testing any flowable material for a rheological property and neither contemplate nor suggest compiling data derived from conditions associated with an engine test. Accordingly, new Claim 33 is believed to be nonobvious, and therefore patentable, over Kolosov et al. Similarly, new Claims 34 and 35, which depend from new Claim 33, are also believed to be nonobvious, and therefore patentable, over Kolosov et al. for at least the same reasons as new Claim 33.

In the last Office Action mailed September 5, 2007, the Examiner rejected Claims 27-30 under 35 U.S.C. §103(a) as being unpatentable over Kolosov et al. in view of Smrcka et al., European Patent No. 1233361 ("Smrcka et al.").
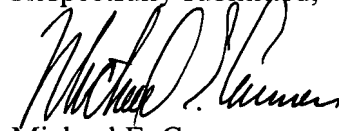
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The foregoing deficiencies of Kolosov et al. discussed above with respect to the rejection of Claim 20, from which Claims 27-30 ultimately depend, apply with equal force to this rejection. Specifically, there is no teaching, motivation or suggestion in Kolosov et al. of a high throughput method for producing a combinatorial lubricating oil composition library, under program control, comprising "(a) providing a library of a vast number of a plurality of different lubricating oil composition samples comprising (i) a major amount of at least one base oil of lubricating viscosity and (ii) a minor amount of at least one lubricating oil additive ... wherein the plurality of different lubricating oil compositions have a phosphorous content at or below 0.08 wt. % and a sulfur content below 0.2 wt. %; (b) measuring lubricating oil composition properties of each sample to provide lubricating oil composition property data for each sample; and, (c) outputting the results of step (b)" as presently recited in amended Claim 20.

In contrast, Kolosov et al. simply disclose a system and method for screening a library of a multitude of genera of flowable material for rheological properties. Kolosov et al. further disclose that one of the genera of material which can be tested includes lubricants, which may or may not contain an additive. However, Kolosov et al. has no appreciation that a combinatorial lubricating oil composition library can be produced by high throughput screening method of a plurality of different lubricating oil composition samples having a phosphorous content at or below 0.08 wt. % and a sulfur content below 0.2 wt. % comprising (i) a major amount of at least one base oil of lubricating viscosity and (ii) a minor amount of at least one lubricating oil additive.

Smrcka et al. do not cure and is not cited as curing the above-noted deficiencies of

Kolosov et al. Rather, Smrcka et al. is merely cited for its disclosure of storing test results in a

data carrier. Accordingly, Claims 27-30 are believed to be nonobvious, and therefore patentable,

over Kolosov et al. and Smrcka et al. Thus, withdrawal of the rejection of Claims 27-30 under

35 U.S.C. §103(a) is respectfully requested.

For the foregoing reasons, amended Claims 1-16 and 18-32 and new Claims 33-35 as

presented herein are believed to be in condition for allowance. Such early and favorable action

is earnestly solicited.

Respectfully submitted,

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